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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,415	01/30/2004	Philip Emery	7015	6942
7590	09/16/2005		EXAMINER	
Gauthier & Connors, LLP Suite 3300 225 Franklin Street Boston, MA 02110			SHEWAREGED, BETELHEM	
			ART UNIT	PAPER NUMBER
			1774	

DATE MAILED: 09/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/768,415	EMERY ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Betelhem Shewareged	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 30 January 2004.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1,3-20 and 22-24 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1,3-20 and 22-24 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/2/04.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 17 is objected to because of the following informalities: The term "layer" is misspelled as 'later'. Appropriate correction is required.
2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).
3. Misnumbered claim 25 has been renumbered 24.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 4-15, 20 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Lin et al. (US 5,190,609).

Lin discloses a heat shrinkable label comprising a backing sheet (col. 2, line 42), a first pressure sensitive adhesive (PSA) on the backing layer (col. 2, line 56), a first shrinkable layer on the first PSA (col. 2, line 44), graphics on the first shrinkable layer (col. 3, line 23), a second pressure sensitive adhesive (PSA) on the graphics (col. 3, line 32), and a second shrinkable layer on the second PSA (col. 2, line 44). The shrinking

temperature of the first and second shrinkable layers is 240-250 degree F (col. 3, line 56), and the layers are made of polypropylene (col. 2, line 45). The thickness of the shrinkable layer is 1.25 mils (col. 4, line 63). With respect to the claimed stiffness value, it is elementary that the mere recitation of newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. *In re swinehart et al.*, 169 USPQ 226 at 229. Since the Lin reference teaches substantially identical material, it is inherent that the reference article function in the same manner claimed by Applicant. The burden is upon Applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3, 22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lin et al. (US 5,190,609), as applied to claims 1, 4-15, 20 and 23, above, and in further view of Ast (US 6, 248,427 B1).

Lin does not teach the use of polystyrene as the shrinkable layers.

Ast teaches adhesive label comprising a shrinkable cover foil that can be made of polypropylene, polystyrene, polyethylene or polyester (col. 3, lines 37-42).

Lin and Ast are analogous art because they are from the same field of endeavor that is the heat shrinkable art. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use polystyrene to make the shrinkable layers of Lin since the examiner takes Official Notice of the equivalence of polyethylene and polystyrene for there use in the heat shrinkable art and the selection of any of there known equivalents to make the shrinkable layers would be within the level of ordinary skill in the art.

8. Claims 1 and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ast (US 6,248,427 B1) in view of Lin et al. (US 5,190,609).

Ast discloses an adhesive shrinkable label comprising a carrier (col. 4, line 17), an adhesive on the carrier (col. 4, line 15), a carrier material on the adhesive (col. 4, lines 7-13), wherein the carrier material comprises metallic layer and non-metallic layer, a laminating adhesive on the carrier material (col. 5, line 52), imprints on the laminating adhesive, and a shrinkable cover foil on the imprint (col. 3, line 39). The shrinkable cover foil comprises polyethylene, however, Ast does not teach the shrinking temperature value of the shrinkable cover foil. The shrinking temperature value would fall within the claimed range because Lin teaches the use of polyethylene as the shrinkable layer and this layer shrinks at a range of 240-250 degree F (col. 3, line 56 of Lin).

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***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 571-272-1529. The examiner can normally be reached on Mon.-Fri. 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

B.S.  
August 5, 2005.



BETELHEM SHEWAREGED  
PRIMARY EXAMINER